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[REDACTED] EXAMINER

COOLEY, CHARLES E

ART UNIT	PAPER NUMBER
1723	

DATE MAILED: 05 21 2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)
09/082,200	Jorgensen et al.
Examiner	Art Unit
Charles Cooley	1723



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on 5 Dec 2002.

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-48 is/are pending in the application.

4a) Of the above, claim(s) 10, 11, 28-33, and 45-47 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-9, 12-27, 34-44, and 48 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims 1-48 are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 9 Nov 1998 is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited PTO-892           | 4) <input type="checkbox"/> Interview Summary PTO-413 Paper No s          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review PTO-948  | 5) <input type="checkbox"/> Notice of Informal Patent Application PTO-152 |
| 3) <input type="checkbox"/> Information Disclosure Statement s' PTO-1449 Paper No s | 6) <input type="checkbox"/> Other   |

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## OFFICE ACTION

1. This application has been reassigned to another examiner in Art Unit 1723 and the following will apply for this application:

- a. Please direct all written correspondence with the correct application serial number for this application to Art Unit 1723.
- b. Telephone inquiries regarding this application should be directed to the Technology Center 1700 receptionist at ~~(703)~~ 308-0651 or to the Examiner at ~~(703)~~ 308-0112. Official facsimile correspondence filed before a final office action should be transmitted to ~~(703)~~ 872-9310. Official facsimile correspondence which responds to a final office action should be transmitted to ~~(703)~~ 872-9311. All post-allowance papers (e.g., Information Disclosure Statements, Rule 312 Amendments, petitions, etc.) should be mailed to **Box Issue Fee** or submitted via facsimile to ~~(703)~~ 308-5864.

### *Election/Restriction*

2. Claims 10, 11, 28-33, and 45-47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 7 (see section (7) thereof).
3. However, the response filed 5 DEC 2002 traverses the restriction requirement on the grounds of efficiency and asserts all three groups are related. This is not found

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persuasive because with regard to apparatus claims versus method claims, in apparatus claims the material or article worked upon does not limit apparatus claims and is not a major consideration when determining the patentability of said apparatus claims (MPEP 2115). "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). In stark contrast thereto, in method claims the materials on which a process is carried out must be accorded weight in determining the patentability of a process. *Ex parte Leonard*, 187 USPQ 122 (Bd. App. 1974) and see MPEP 2116. Accordingly, unlike the elected apparatus claims, patentable weight must be given to the claimed materials set forth in the pending nonelected method claims which significantly alters the search strategy and amplifies the searching required which leads to a burden on the PTO. Clearly, consideration of additional claims drawn to distinct groups of inventions mandate divergent search fields (and the concomitant hundreds to thousands of patents) and time consuming consideration of those patents which gives rise to a substantial burden on the PTO.

Nonetheless, Applicant apparently feels the restriction requirement rises to the level of an injustice. If this feeling lingers, the examiner would be remiss in not urging

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Applicant to petition for relief pursuant to 37 CFR 1.44 since the requirement is still deemed proper and is therefore made FINAL. However, any such petition may be deemed moot by the petitions officer since Applicant is considered to have elected without traverse in Paper No. 7.

4. This application contains claims 10, 20-22, and 28-30 drawn to an invention nonelected without traverse in Paper No. 7. A complete reply to this final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Priority***

5. Acknowledgment is made of applicant's claim for domestic priority under 35 U.S.C. § 119(e).

***Drawings***

6. The drawings are objected to because of the following informalities:

- a. passage 459 does not appear to be labeled in the appropriate Figure(s) - see page 11, line 12
- b. exit port 470 does not appear to be labeled in the appropriate Figure(s) - see page 13, line 4.

Correction is required.

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7. Applicant should therefore verify that (1) all reference characters in the drawings are described in the detailed description portion of the specification and (2) all reference characters mentioned in the specification are included in the appropriate drawing

Figure(s) as required by 37 CFR 1.84(p)(5).

8. The drawings are objected to because suitable descriptive and concise legends should be provided to label the depicted elements of the invention such as the pump 502, expressor fluid source 425, fluid heating/cooling device 506, etc. for understanding of the drawings ( 37 CFR 1.84(o)). Note the cited patent to Headley et al. '253 for a suggested format. All of the boxes having a reference character therein should be properly labeled in this manner.

9. Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must include a print or pen-and-ink sketch showing changes in *red ink* in accordance with MPEP § 608.02(v).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketch with proposed corrections shown in red ink is required in response to this Office Action, and *may not be deferred*.

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***Specification***

10. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

11. The disclosure is objected to because of the following informalities:

a. Page 1: the status of the related application should be updated as appropriate.

b. Page 1, line 21: replace "Paten" with --Patent--.

c. Page 3, line 13: replace "dravably" with --drivably--.

d. Page 11, line 13: insert --410-- after "grooves" to clarify the description.

e. Page 16, line 26: "4011" is an erroneous reference character.

Appropriate correction is required.

12. The use of the trademarks have been noted in this application at page 11, line 29 through page 12, line 1. They should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

13. The Abstract of the Disclosure is acceptable.

14. The title is acceptable.

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15. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and M.P.E.P. § 608.01(l).

Correction of the following is required:

a. The amendatory language added to claims 1, 12, 23, 34, and 40 in the response filed 5 DEC 2002 lacks positive antecedent basis in the specification.

***Claim Rejections - 35 U.S.C. § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 23, 26-27, 34, 36, 39-40, and 44 are rejected under 35 U.S.C. § 102(b) as being anticipated by Brierton (US 5,356,365).

The claims are rejected for the reasons set forth in section (16) of the previous office action, Paper No. 7 which are incorporated by reference. The amendatory language added to claims 23, 34, and 40 regarding the channel is met by the channel shown in Fig. 1 of Brierton (the horizontal channel above 58) or by the channel 118 shown in Figs. 2 and 5 of Brierton. The channel is provided in the centrifuge rotor 14 or 90 as seen in these Figures. Although the only structure added to the apparatus claims is a channel provided on the rotor, note the channel functions to direct the expressor

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fluid 54 from the central axis (at 58 or 198) radially outward towards a circumference (i.e., outward region) of the rotor (as explained by col. 5, lines 57-64).

***Claim Rejections - 35 U.S.C. § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20. Claims 1-9, 12-22, 24-25, 37-38, and 42-43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Brierton (US 5,356,365) in view of Hein (US 3,244,362).

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The claims are rejected for the reasons set forth in section (18) of the previous office action, Paper No. 7 which are incorporated by reference. The amendatory language added to claims 1 and 12 regarding the channel is met by the channel shown in Fig. 1 of Brierton (the horizontal channel above 58) or by the channel 118 shown in Figs. 2 and 5 of Brierton. The channel is provided in the centrifuge rotor 14 or 90 as seen in these Figures. Although the only structure added to the apparatus claims is a channel provided on the rotor, note the channel functions to direct the expressor fluid 54 from the central axis (at 58 or 198) radially outward towards a circumference (i.e., outward region) of the rotor (as explained by col. 5, lines 57-64). Note claims 6 and 17 were not amended by the response filed 5 DEC 2002 so the rejection directed to these claims set forth in section (18) of the previous office action remains valid.

21. Claims 35, 41, and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Brierton or Brierton in view of Hein as applied to claims 1, 34, and 40 above, and further in view of Perry et al. (Perry's Chemical Engineer's Handbook, 6th edition).

The claims are rejected for the reasons set forth in section (19) of the previous office action, Paper No. 7 which are incorporated by reference.

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***Response to Amendment***

22. Applicant's arguments filed 5 DEC 2002 upon revival have been fully considered but they are not deemed to be persuasive.

Applicant is reminded that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Turning to the rejection of the claims under 35 U.S.C. § 102(b), it is noted that the terminology in a pending application's claims is to be given its broadest reasonable interpretation (*In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (*Sjolund v. Musland*, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)). Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See *Constant v. Advanced Micro-Devices, Inc.*,

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848 F.2d 1560, 1570, 7 USPQ2d 1057, 1064 (Fed. Cir.), cert. denied, 488 U.S. 892 (1988); *RCA Corp. v. Applied Digital Data Sys.. Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of properties that are inherently possessed by the prior art reference. *Verdegaal Brothers Inc. v. Union Oil co. of California*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim when that reference discloses each and every element set forth in the claim (*In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990)); however, the law of anticipation does not require that the reference teach what Applicant is claiming, but only that the claims "read on" something disclosed in the reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984) (and overruled in part on another issue), *SRI Intel v. Matsushita Elec. Corp. Of Am.*, 775 F.2d 1107, 1118, 227 USPQ 577, 583 (Fed. Cir. 1985). Also, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. See *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), cert. denied,

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116 S.Ct. 1362 (1996), quoting from *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962).

With respect to the applied prior art under 35 U.S.C. § 102(b), the examiner has explicitly demonstrated how the reference discloses each and every element set forth in the claims and how the pending claims read on the disclosure of the reference, hence the rejection is considered proper.

As set forth above and contrary to Applicant's arguments, the patent to Brierton discloses the broadly recited channel added by amendment.

In conclusion, the amendments made in the instant application are not deemed of a substantive nature to define over the prior art and thus the rejections are considered proper.

### ***Conclusion***

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited prior art discloses centrifuges employing elastic membranes.

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT

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MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION. **ANY RESPONSE FILED AFTER THE MAILING DATE OF THIS FINAL REJECTION WILL BE SUBJECT TO THE PROVISIONS OF MPEP 714.12 AND 714.13.**

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Charles Cooley whose telephone number is **(703) 308-0112.**

26. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is **(703) 308-0651.**

Dated: **15 May 2003**



**Charles Cooley  
Primary Examiner  
Art Unit 1723**